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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,535	07/16/2003	Takeshi Nakayama	62478-5317	9091
21611	7590	05/05/2006	EXAMINER	
SNELL & WILMER LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			DO, THUAN V	
			ART UNIT	PAPER NUMBER
			2825	

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/620,535

Applicant(s)

NAKAYAMA ET AL.

Examiner

Thuan Do

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 91-93 and 99-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 91-93 and 99-102 is/are rejected.
- 7) ☒ Claim(s) 103-105 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/771,843.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This non-final office action is responsive to amendment entered on 04/12/2006. The selected claims 91-93,99-105 are pending in this office action. The non selected claims are requested to cancel in the next response.

Examiner thanks for interview with Joseph price on 04/28/2006 for cancellation of non-elected claims if the application is in an allowance condition but unfortunately the prior art of Miura, patent no. 5847968 was found as rejection as following rejections.

### **DOUBLE PATENTING**

2. Claims 91-93,99,100 are rejected on the ground of nonstatutory double patenting over claims 10,19 of U. S. Patent No. 6631509 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claims 91-93,99,100 of current application: a position information storage step for storing a set of position information which is made up of information showing a position on a wiring board of

- (a) a position dependent component, or a pin thereof, and
- (b) one or more effected components, or pins thereof, which are potentially effected by the position dependent component,

a retrieval step for retrieving from the position dependent component or the pin thereof, based on the sets of position information stored in the position information storage step, for each effected component thereof, whether the effected component or the pin thereof is within a predetermined distance from the placement the pins dependent component or the pin thereof, or for retrieving a predetermined number of effected components or pins thereof in a predetermined order; and

a relationship information storage step for storing the effected component or the pin of the effected component retrieved in the retrieval step in relation with the position dependent component or the pin thereof from which the retrieval was performed, as relationship information.

Claims 10 or 19 of 6631509 prior art: position information storage means for storing a sets of position information which is made up of information showing a position on a wiring board of (a) a position dependent component, or a pin thereof, and (b) one or more effected components, or pins thereof, which are potentially effected by the position dependent component, retrieval means for retrieving from the position dependent component or the pin thereof, based on the sets of position information stored by the position information storage means, for each effected component or the pins thereof, whether the effected component or the pin thereof is within a predetermined distance from the placement dependent component or the pin thereof, or for retrieving a predetermined number of effected components or pins thereof in a predetermined order; and relationship information storage means for storing the effected component or the pin of the effected component retrieved by the retrieval means in relation with the position dependent component or the pin thereof from which the retrieval was performed, as relationship information.

20010034875

Similarity, claims 91-93,99,100 are rejected on the ground of nonstatutory double patenting over claims 69,78,91-93,99,100 of U. S. Publication No. 20010034875.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 91-93,99-102 are rejected under 35 U.S.C. 102(b) as being unpatentable over the prior art of Miura et al. Pat. No. 5847968.

**Regarding claim 91:** The prior art teaches a program comprising:

a position information storage step for storing a set of position information which is made up of information showing a position on a wiring board of (col. 1, lines 9-12)

(a) a position dependent component, or a pin thereof (col. 1, lines 9-12), and

(b) one or more effected components, or pins thereof, which are potentially effected by the position dependent component (col. 18, lines 10-31),

a retrieval step for retrieving from the position dependent component or the pin thereof, based on the sets of position information stored in the position information storage step, for each effected component thereof, whether the effected component or the pin thereof is within a predetermined distance from the placement the pins dependent component or the pin thereof, or for retrieving a predetermined number of effected components or pins thereof in a predetermined order (col. 21, lines 5-25, col. 3, lines 50-67, col. 23, lines 30-43) ; and

a relationship information storage step for storing the effected component or the pin of the effected component retrieved in the retrieval step in relation with the position dependent component or the pin thereof from which the retrieval was performed, as relationship information (col. 5, lines 22-37).

**Regarding claims 101,102:** The prior art teaches a program with noise (col. 3, lines 21-33).

The remaining claims of 102(b) section contain features similar to the rejection of above claims and rejected in the rationale.

***Allowable Subject Matter***

Claims 103-105 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reason for allowance is that the prior art of record does not teach the dependent claims with all other features of corresponding independent claim.

**CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Do whose telephone number is 571-272-1891. The examiner can normally be reached on Monday-Friday 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Chiang can be reached on 571-272-7483. The fax phone numbers for proceeding this application is 571 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 800-786-9199.



Thuan Do  
Primary examiner  
04/28/2006